



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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In re application of :  
James W. Schumm et al. :  
Serial No. : 09/784,423 : DECISION ON PETITION  
Filed : February 15, 2001 :  
Attorney Docket No.: 16026-9180-05 :

This is in response to applicants' petition, filed June 3, 2003 under 37 C.F.R. 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

## BACKGROUND

Review of the file history shows that the instant application was filed February 15, 2001 under 37 CFR 1.53(b), as a divisional application of 09/018,584, filed February 4, 1998. The application as filed contained claims 1-21. A preliminary amendment cancelled claims 1-21 and added claims 22-34. On October 1, 2002 the examiner mailed a restriction requirement dividing the claims into 2 groups. The examiner further required election of a single nucleic acid sequence for examination. In a response filed November 6, 2002, applicants elected Group I, claims 22-32 (claims 31 and 32 had mistakenly been included in Group II, as acknowledged by the examiner), and further elected the marker sequence SEQ ID NO: 32 and the corresponding primer pair SEQ ID NO: 124 and SEQ ID NO: 125. Applicants traversed the restriction on the grounds that 10 sequences should be examined, citing MPEP 803.04. On January 17, 2003 the examiner mailed a first Office action on the merits. The examiner maintained the restriction requirement, explaining that it is no longer practical for the USPTO to search 10 sequences per application, due to the rapid increase in the size of the nucleotide sequence databases.

## DISCUSSION

In the petition applicants argue that the "unofficial policy" of the examiner and the art unit is unfair. This argument is not persuasive. First, it is noted that MPEP 803.04 *permits* the examination of more than one independent and distinct invention – it does not *require* the examination of ten nucleotide sequences. Restriction is discretionary (MPEP 803.01).

Second, the claims in the instant application are not in the same form as the examples provided in MPEP 803.04. Moreover, the examiner is not required to search 10 sequences in any event – MPEP 803.04 states that *up to ten* nucleotide sequences will be searched. Finally, the examiner is required to demonstrate that it would be a serious burden to search all of the claimed inventions (MPEP 803). While not articulating the issue in these terms, the examiner has explained why it would be a burden to search and examine ten nucleotide sequences, and there is no evidence of record to suggest that the various nucleotide sequences are not independent and distinct. Therefore the restriction requirement is deemed proper.


## **DECISION**

Applicants' petition is **DENIED** for the reasons discussed above.

The application will be forwarded to the examiner for consideration of the amendment filed June 3, 2003.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

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Director, Technology Center 1600